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In re Application of
KENNEDY *et al*
U.S. Application No.: 10/526,515
PCT No.: PCT/US03/27804
Int. Filing Date: 04 September 2003
Priority Date: 04 September 2002
Attorney Docket No.: HMI P1191US1
For: SPACE DIVISION SYSTEM

DECISION

This decision is in response to applicants' petition under 37 CFR 1.47(a) filed 05 June 2006.

BACKGROUND

On 04 November 2005, the DO/EO/US mailed a Notification of Missing Requirements Under 35 U.S.C. 371 (Form PCT/DO/EO/905) indicating that an oath or declaration in compliance with 37 CFR 1.497(a) and (b) and a surcharge fee was required. Applicants were given two months to respond with extensions of time available.

On 05 June 2006, applicants filed a response which was accompanied by, *inter alia*, the subject petition, a declaration signed by three of five eight named inventors; an affidavit of Thomas Lockhart; an affidavit of Jodi Russo; a five-month extension and fee; the petition fee of \$200.00; and the \$130.00 surcharge fee.

DISCUSSION

Applicants claim that Joseph Chi-Chen Ho and Bill Chen-Hsun Yen cannot be located after a diligent effort and have filed the subject petition in response to the Form PCT/DO/EO/905 mailed 04 November 2005.

A petition under 37 CFR 1.47(a) requires: (1) the petition fee; (2) factual proof that the missing joint inventors cannot be located or refuse to cooperate; (3) a statement of the last known addresses of the nonsigning joint inventors; (4) and an oath or declaration executed by the signing joint inventors on their behalf and on behalf of the nonsigning joint inventors.

Concerning item (1), the petition fee of \$200.00 has been paid.

Regarding item (2), applicants' burden in showing that an inventor cannot be located is explained in section 409.03(d) of the MPEP which states, in part:

Where inability to find or reach a nonsigning inventor 'after diligent effort' is the reason for filing under 37 CFR 1.47, an affidavit or declaration of the facts should be submitted that fully describes the exact facts which are relied on to establish that a diligent effort was made . . .

The statement of facts must be signed, where at all possible, by a person having firsthand knowledge of the facts recited therein. Statements based on hearsay will not normally be accepted. Copies of documentary evidence such as internet searches, certified mail return receipts, cover letters of instructions, telegrams, that support a finding that the nonsigning inventor could not be found or reached should be made part of the statement. The steps taken to locate the whereabouts of the nonsigning inventor should be included in the statement of facts. It is important that the statement contain facts as opposed to conclusions . . .

In this case, petitioners have submitted declarations by Thomas L. Lockhart and Jodi Russo explaining the attempts to locate the nonsigning inventors. These attempts include various telephone and internet searches performed and contacting the nonsigning inventor's former employers for any additional information. Petitioners also provided the requisite documentary evidence in the form of internet searches etc. to substantiate their claim. This evidence is sufficient to show that a diligent effort was made to locate the nonsigning inventors and meet the requirements of the MPEP. Item (2) of 37 CFR 1.47(a) is satisfied.

With regards to item (3), the last known address of co-inventor Joseph Chi-Chen Ho is listed as:

143 Albany Street, #223
Cambridge, MA 02139

The last known address of co-inventor Bill Chen-Hsun Yen is listed as:

5892 169th Ave.
Bellevue, WA 98006

Concerning item (4), the 37 CFR 1.47(a) applicant submitted a declaration signed by three of the five co-inventors on behalf of themselves and the nonsigning joint inventor. This declaration meets the requirements of section 409.03(a) and is in

compliance with 37 CFR 1.497(a) and (b).

All requirements of 37 CFR 1.47(a) are complete.

CONCLUSION

Applicants' petition under 37 CFR 1.47(a) is **GRANTED**.

Applicants have completed the requirements for acceptance under 35 U.S.C. 371(c). The application has an international filing date of 04 September 2003 under 35 U.S.C. 363, and a 35 U.S.C. 371 date of 05 June 2006.

As provided in 37 CFR 1.47(a), a notice of the filing of this application will be forwarded to the non-signing inventor at his last known address of record and will be published in the Official Gazette.

This application is being forwarded to the National Stage Processing Division of the Office of PCT Operations for continued processing.



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